

Applicant : Peter M. Perthou  
 Serial No. : 09/752,015  
 Filed : December 29, 2000  
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Attorney's Docket No.: 08914-009001

REMARKS

## 1. The office action states:

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claim of U.S. Design Patent No. D435,720. Although the conflicting claims are not identical, they are not patentably distinct from each other because the design patent clearly shows all of the claimed structure of the instant utility patent application and the utility patent claims all of the structure shown in the design patent as evidenced by the identical drawings figures in both the utility application and the design patent. Accordingly, two-way obviousness determination is satisfied. Pp.2-3.

In order to support a rejection of claims for double patenting based on a design patent, double patenting can be found only if the claims of the two patents either cross-read or constitute obvious variations in both directions. Design patent D435,720 is restricted to "The ornamental design for a key ring, substantially as shown and described." Claim 1 in this application, for example, is considerably broader in calling for a key-holding ring, a band, a D-ring coupling said band to said key-holding ring, said D-ring having a U-shaped portion engaging the key-holding ring and a bar between the ends of the U-shaped portion and engaging the band. The claimed structure is not limited to the ornamental design of the design patent, and the narrow claim to the ornamental design in the design patent is plainly patentable over the utility patent claims. That

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the drawing figures are the same does not support a conclusion that the claims of the design patent and the utility patent constitute obvious variations in both directions. A device could be constructed that would infringe the claims of the utility patent but not the claim of the design patent. *Shelcore, Inc. v. Durham Industries Inc.*, 223 U.S.P.Q. 584 (Fed. Cir. 1984) Accordingly, withdrawal of the rejection of claims 1-11 as unpatentable over the claim of the design patent is respectfully requested.

The office action states:

4. Claims 1,6,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen 5,069,050 in view of Jung 4,903,514, and Momemers 4,523,443 or Sheldon 4,601,185. Chen teaches a flexible web band member 16 having a key ring 12 attached to one end. Jung teaches a keyholder comprising an intermediate member between the member 11 and key ring 15 in the form of a D-ring having a "V" shaped portion connecting one end of the band and the key ring. The D-ring further comprises a gap portion to be attached to the band and a clip means 20/21/22 to clamp the other end of the band together. Jung fails to teach a D-ring having a "U" shaped portion. Momemers teaches a similar key ring comprising a D-ring with a "U" shaped portion 3. Or alternatively, Sheldon teaches both "V" and "U"-shaped rings in Figure 2. It would have been considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and key ring of Chen as taught by Jung since it well known in the key ring art to provide as many intermediate members as desired due to the ease of attaching multiple rings together, and further to substitute a "U" shape for the "V" shaped D-ring of Jung since the varying shapes of rings are well known and there is no criticality afforded the U-shape. Furthermore, the method limitations of claim 11 are considered inherent to the device of Chen, as modified by Jung, and Momemers or Sheldon. Pp. 3-4.

This ground of rejection is respectfully traversed. We rely on the authorities set forth on pages 4 and 5 of the brief for appellant mailed April 28, 2003.

Nothing in the references remotely suggests the desirability of combining what is there disclosed to meet the terms of the rejected claims. Furthermore, the contention that it would have been considered an obvious matter of design choice to one of ordinary skill in the art to provide an intermediate member between the band and key ring of the primary reference as said to be taught by the secondary reference is a conclusion, not a proper reason for sustaining a rejection under section 103.

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In *In Re Garrett*, 33 PTCJ 43 (BPA & I, September 30, 1986) the Board criticized the Examiner's statement that the proposed modification would have been "an obvious matter of engineering design choice" as a conclusion, not a reason, in reversing the section 103 rejection.

The rejection of method claim 11 as inherent to the device of the primary reference as modified by the secondary reference and either tertiary reference by hindsight is improper. "In the absence of the article in the prior art we find no basis for the conclusion that the manipulative steps of assembling the non-existent article would be obvious." *Ex Parte Rubin*, 127 U.S.P.Q. 286, 287 (Bd. of Appeals 1959).

Accordingly, withdrawal of the rejection of claims 1, 6 and 11 as unpatentable over the primary reference in view of the secondary reference and either tertiary reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each limitation in each rejected claim and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the rejected claims.

The office action states:

5. Claims 2-5,7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen in view of Jung and Momemers or Sheldon, as applied to claim 1 above, and further in view of Miller 1,704,137. Chen fails to teach the ends of the band being joined together as set forth in claim 2. Miller teaches a band 12/14 looped through a key ring 20, fastened along most of its sides by snaps 28 or alternatively by stitching 30, and joined at its ends by a clamp means comprised of stitching 16/30 extending along the entire width of the band. It would have been obvious to one of ordinary skill in the art to modify the band of Chen by providing a fastening along most of its length and stitch clamp means for joining the ends as taught by Miller as a well known alternative manner of constructing the band member and providing strengthening means by doubling up on most of the length, rather than the shortened leg 18D,18E of Chen. P.4.

This ground of rejection is respectfully traversed. Claims 2-5 and 7-10 are dependent upon and include all the limitations of parent claim 1, and the reasoning set forth above in support of the patentability of claim 1 over the primary, secondary, and either tertiary reference

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is submitted to support the patentability of claims 2-5 and 7-10 so that further discussion of the quaternary reference is submitted to be unnecessary.

If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in each reference regarded as corresponding to each limitation in the rejected claims and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the limitations of these claims.

7. The courtesy of the Examiner in conducting an additional diligent search is acknowledged with appreciation. The references cited but not applied, are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the forgoing authorities, remarks and the inability of the prior art alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, she is respectfully requested to telephone the undersigned attorney at 617-521-7014 to discuss what additional steps she believes are necessary to place the application in a condition for allowance.

Respectfully submitted,  
FISH & RICHARDSON P.C.

AUG 30 2005

Date: \_\_\_\_\_

  
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